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EXAMINER

MULLIS, JEFFREY C

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/791,049
Filing Date: March 02, 2004
Appellant(s): WANG ET AL.

Nathan T. Lewis
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1-5-2010 appealing from the Office action mailed 3-1-2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Serial number 11/104,759 has related subject matter and is currently under Appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: Wooley is no longer relied upon..

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. All grounds of rejections based on Wooley JP '791 are hereby withdrawn.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,437,050

Krom et al.

8-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10-17, 23-25, 27-31 and 34-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Krom (US 6,437,050).

See the paragraph bridging pages 7 and 8 of the Office action of 9-11-08.

(10) Response to Argument

There is no disclosure on page 6 of appellants specification (and elsewhere also as appellants urge) that the discussion using the term "mono-block" is meant to be a definition. Furthermore, the term "separate" in the context of the discussion in the first paragraph on page 6 is redundant if it assumed that a monoblock can not be bound chemically to another moiety or material and therefore the term "separate" if anything would lead those of ordinary skill to conclude that the monoblock may or may not be attached to anything else. Appellants in fact further urge that the claims be interpreted such that "(T)he chains are then cross-linked together at the core" (see appellants brief

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at page 9, line 11), i.e. the "separate" mono-block is in fact chemically bound via the core to the diblock polymer chains (although apparently not directly to the diblock chains). Appellants were free to amend their claims to recite such features but chose not to. Unpatented claims are given their broadest reasonable interpretation consistent with the specification which in the instant case does not disclose that the mono block formed from the second monomer can not be bound directly to the first block as well as being separate. Appellants argue that such an interpretation is not consistent with their specification. However, there would have been nothing inconsistent with a disclosure that "(T)he second monomer polymerizes onto the first polymer to form a diblock polymer containing a mono-block of the second monomer as well as forming a separate second polymer which is a mono-block polymer". Furthermore, even if appellants' narrow interpretation of the claims is accepted, the claims are still anticipated by Krom. Note in this regard Example 2 in column 6 where a second charge of butyl lithium was added in the presence of 2.27 kg of 21.6% butadiene such as would inherently produce a mono block separate and not bound directly with the diblock previously formed. Appellants argue that the examiner no longer claims that Krom does not make nanoparticles with mono block polymer chains given appellants 1.132 declaration. This is not true and would not be true even if Examples 2 and 3 of Krom were absent. Firstly, Appellants' allegations 5-10 of their declaration ignores the second addition of initiator in Example 2 of Krom and appellants' allegations therefore improperly do not consider the entire teachings of Krom which do reasonably disclose a separate mono block (assuming for the sake of argument that it is proper to read the limitation of a "separate"

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mono-block into the claims from the specification). For this reason alone appellants' declaration fails to overcome the reference. Secondly, (even ignoring Examples 2 and 3 of Krom) the declaration improperly interprets the claims such that claim 10 requires a separate mono-block despite the fact that no such limitation is present in the claims. For this reason alone also appellants' declaration fails to overcome the reference. Lastly and thirdly, Krom discloses the addition of polybutadiene (see Examples 6 and 7 of Table 3 of Krom in this regard) such as reads on even "separate" mono-block (although admittedly unlike Kroms' Examples 2 and 3 the "butadiene rubber" reading on appellants' mono-block would not be bound to the core) and also for this reason alone appellants' declaration fails as it does not consider this teaching of Krom. With regard to claims 36 and 37, discussed on page 13 of appellants brief, all examples of Krom use amounts of monomeric charges which are within the ratio of 90:10 to 10:90 such as would produce the required ratio of these claims. The last digit in a number is understood by those skilled in the art to be uncertain and thus the ranges of the prior art and the claims practically overlap even ignoring the fact that both the reference and claims recite ranges modified by "about". Unpatented claims are given their broadest reasonable interpretation and the examiner's interpretation of the claimed range as overlapping with the upper range of the reference of "about 1.3" is more than reasonable. Note page 7, line 4 to page 8, line 4 of the instant specification where polydispersity including bimodality is disclosed to result from use of "relatively high monomer concentration during polymerization" such as 10-20% (page 7, lines 1-4) and note that the examples of Krom discloses similar concentrations.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Jeffrey C. Mullis

/Jeffrey C. Mullis/

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/James J. Seidleck/

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JCM

3-8-2010